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OCT 05 2010

Application No. 09/921,844
Amendment dated October 5, 2010
Reply to Final Office Action of April 5, 2010**REMARKS**

Applicant added new claims 287 to 291 to further define Applicant's claimed invention. Support for claims 287 to 290 is found at least in Figs. 12 and 13. Support for claim 291 is found at least in Figs. 12, 14 and 15. New claims 287 to 291 read on elected species 3, Figs. 12 to 15.

In the Office Action, the Examiner rejected claims 1, 3, 5, 19-56, 203, 204, 207-209, 219, 228-254, 259-271, and 277-284 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,482,233 to Aebi et al. ("Aebi") in view of U.S. Patent No. 6,592,624 to Fraser et al. ("Fraser"); and rejected claims 1, 3, 5, 19-56, 203, 204, 207-209, 219, 228-254, 259-271, and 277-284 under 35 U.S.C. § 103(a) as being unpatentable over Fraser in view of U.S. Patent No. 6,258,125 to Paul et al. ("Paul").

Applicant respectfully traverses the rejections. The Examiner states that "[i]t would have been obvious to one having ordinary skill in the art to have formed the rearward facet of Aebi et al forming a negative slope such that the length of the forward facing facet is greater than the maximum length of the base such that the projections dig into the bone and better resist expulsion." (Office Action, p. 4, third paragraph). It is respectfully submitted that the Examiner is using impermissible hindsight by gleaning the rationale used to reject the present claims over Aebi, Fraser and Paul from Applicant's own teachings in the specification. (See MPEP § 2141.01(III), page 2100-121, col. 1 (Rev. 6, Sept. 2007) ("[i]t is difficult but necessary that the decision-maker forget what he or she has been taught...about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." (citation omitted))). Applicant respectfully submits that the rejection was not framed with the mind of one skilled in the art presented only with the references and then-commonly accepted wisdom in the art, but with the guidance of Applicant's teachings. In the specification, Applicant teaches that a "[s]urface configuration 320 includes surface projections 322 to facilitate insertion

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of implant 100 into an implantation site while resisting expulsion of implant 100 in a direction opposite to the direction of insertion." (Specification, page 13, lines 6-9; see also, page 13, lines 15-17). The notion of configuring surface projections with the slopes recited in independent claims 1 and 219 to better resist expulsion is clearly taught by Applicant in the above noted passage and in Figs. 12 to 15. It is therefore submitted that a *prima facie* case of obviousness has not been established.

Applicant submits that independent claims 1 and 219 are patentable and that dependent claims 3, 5, 19-56, 203, 204, 207-209, 228-254, 259-271, and 277-291 dependent from independent claim 1 or 219, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

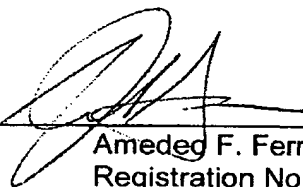
To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: October 5, 2010

By: _____



Amedeo F. Ferraro
Registration No. 37,129

1557 Lake O'Pines Street, NE
Hartville, Ohio 44632
Telephone: (310) 286-9800
Facsimile: (310) 286-2795